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09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/892,732

Applicant(s)

IWAYAMA ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-27-2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is responsive to the correspondence received November 27, 2006. Claims 1-12, 14-15 remain pending. Claim 13 is cancelled. Claims 1, 2, 9, 10, 11, 12, 14-15 are independent.

Specification

2. The previous objection to the abstract is withdrawn in view of the amendment. The amended abstract is accepted.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Previous rejections to claims 1 and 14 under 35 U.S.C. 112, second paragraph, are withdrawn. However new ones under this section apply.

5. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

Step d) “*receiving from a third computer*

the resource identification information, at least one of the plurality of advertising information or a combination thereof, recorded in said recording” is confusing because the following questions arise:

what/who is “receiving”?

receiving into what? the database of step c)?

what is the third computer? a third user computer or an advertiser computer?

“receiving ...**the** resource identification information ... recorded in said recording” (emphasis added) presumes the recording step c) happens before the receiving step d). To be logical “recorded in said recording” should be corrected to “to be recorded in said recording”

Mr. Thomas Jones, on February 9, confirms Appellants mean the third computer to be an advertiser computer, consistently with claims 2-4 which claim “receiving from a third computer..” registered and unregistered ads “to be recorded in said advertising database”, so apparently, the third computer is an advertiser computer).

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For prior art application purposes, claim 1 will so be interpreted, however appropriate corrections are required to resolve the above questions.

step d) “*receiving from a third computer the resource identification information, at least one of the plurality of advertising information or a combination thereof, recorded in said recording*”

further “*at least one of the plurality*” in the phrase “*receivingat least one of the plurality of advertising information*” in step d) is confusing because “*at least one*” means only “one” is possible while step c) claims “*a plurality of advertising information*”, therefore step d) contradicts step c).

Therefore step d) should read “*receiving from a third computer the resource identification information, a plurality of advertising information or a combination thereof, to be recorded in said recording*”

Further to be further consistent with step c) and also with step f) and Applicants argument at page 11, last paragraph, (“*chosen from the recorded plurality of advertising information correlated to the resource identification information ...*”)

, both the resource identification information, and a plurality of advertising information, in step d), have to be received from the advertiser and not one or the other to allow their respective correlation.

Therefore step d) should further read “*receiving from a third computer the resource identification information and a plurality of advertising information to be recorded in said recording*”

Further, in step f) “*extracting first advertising information corresponding to the resource identification information, and recorded in said recording for the first resource, detected in said detection, wherein the extracted first advertising information is chosen from the recorded plurality of advertising information correlated to the resource identification information*”

It seems “*detected in said detection*” modifies “the first resource” while in the detection step e), the detection is the detection of a “*resource identification information*”, thus the “*detected in said detection*” is unclear. Further “*the resource identification information*” in the phrase “*correlated to the resource identification information*” can be “*the resource identification information for the first resource*” or another generic “*resource identification information*”, thus the phrase is confusing.

In order to improve readability and avoid confusion, it is further suggested that step f) be changed to “*extracting first advertising information, recorded in said recording, corresponding to the detected resource identification information for the first resource, wherein the extracted*”

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first advertising information is chosen from the recorded plurality of advertising information correlated to the resource identification information for the first resource".

Claim 14: "to the second computer" lacks antecedent basis.

Appropriate corrections to all the above are required.

6. Response to Arguments:

The arguments with regard to Kirmse are moot as new grounds of rejection are presented in view of the amendments. Recommend-it.com used as 2nd prior art reference earlier is now used as the main reference. Arguments as to Official Notice are addressed below.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 1-4, 9,10, 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recommend-it.com, a set of 3 documents, which date back to 1998, as described further below, in view of Porat et al, US 20020026353 A1.**

"Want to See What We Can Do For Your Website?"

Click The Button To Test Us Out! " at Recommend-it.com , <http://web.archive.org/web/19980610011830/www.recommend-it.com/>, (4 pages, dated back to 1998), herein "Recommend-it document #1", discloses a system where a website (such as www.webdeck.com) browsed by a 1st user (e.g. "Eileen Velet") is detected and an email, disclosing the status of the 1st user ("velvet wants to you to check this site out") is sent to buddies of the 1st user indicating the website just visited by this user (see page 2 , left frame lines 5-7) ,and links to that website so the buddy can visit (see page 4, line 8) . Included in the email is description of the site and other "juicy details" of the site so that the "friend or colleague will see exactly what the site contains before they visit" (see page 4 of 4). The description of the site and the "juicy details" of the site constitute an advertisement for the site to entice the buddy to visit.

Recommend-it #1 further adds more ads in the invitation message (see at page 4, the financial ad "Green Mountain Asset" tagged to the email message).

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Recommend it, [http:// web.archive.org/web/19980610011837/www.recommend-it.com/user_reg.user_regHTML.fcgi](http://web.archive.org/web/19980610011837/www.recommend-it.com/user_reg.user_regHTML.fcgi), herein” Recommend-it document #2”, (2 pages) shows setting up buddy lists to send recommended site identifiers to.

“Advertising rates” at Recommend-it.com, [http:// web.archive.org/web/19980610011859/www.recommend-it.com/html/advert.html](http://web.archive.org/web/19980610011859/www.recommend-it.com/html/advert.html), herein” Recommend-it document #3”, (2pages) discloses solicitation of advertisers and advertising pay rates.

Thus Recommend-it discloses independent claims 1, 10, 12, 14-15

An advertising method, system, computer program for broadcasting advertisements to user operated, network-interconnected computers including a first computer operated by a first user and a second computer operated by a second user, the method including:

- a) administrating status of users including the first user (e.g.” Eileen Velet”) and the second user (her friend)
- b) receiving from the first computer and broadcasting to the second computer the status of the first user (“velvet wants to you to check this site out” means Eileen velvet has been monitored as having visited that site);
- c) correlatively recording in an advertising database (implicit) resource identification information specifying a resource on the network (URL of the game website visited by Eileen Velet”) with a plurality of advertising information (the game site description, the plural pieces of data that constitute “the juicy details” of the game site, also the tagged on other promotion : see at page 4, the financial ad “Green Mountain Asset” tagged to the email message). for the advertisements;
- d) receiving from at least a third (advertiser) computer the resource identification information (RECOMMEND-IT #1 line 2: “ register your site now!”), at least one of the plurality of advertising information (information about the site) or a combination thereof, recorded in said recording
- e) detecting resource identification information for a first resource in use by the first user;
- f) e x t r a c t i n g t first advertising information (e.g. details of the game) corresponding to the resource identification information (URL of the game site) , and recorded in said recording, for the first resource detected in said detection, wherein the extracted first advertising information is chosen from the recorded plurality of advertising information (e.g. details of the game, other ads such as “Green Mountain Asset”) correlated to (implicit) the resource identification information;

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g) broadcasting to the second computer said first advertising information extracted in said extraction; and

h) displaying (in the email) status of the first user on the second computer, said status represented by advertising data (description of the game site in the email shows the status of the 1st user as being at that site previously) included in said first advertising information broadcast, said displaying occurring in response to browsing by said first computer.

Recommend-it does not disclose the ads are represented by "a plurality of image data", however Porat et al. discloses email to buddies recommending a particular page and its URL visited by a shopper can include an image of the item or product viewed by the 1st user (paragraph [0049], see also Figure 7 "tell a friend" button, paragraphs [0048]-[0050]).

Since "a picture is worth a thousand words" it would have been desirable and thus obvious to add Porat's image teaching to the Recommend-it message to describe more efficiently or succinctly the web site (e.g. game site) recommended. It would also have been obvious to use the same picture or icon representation technique to efficiently represent additional ads such as the "Green Mountain Asset" ad tagged to the message. Thus RECOMMEND-IT/Porat discloses "a plurality of image data" and the status of the 1st user being represented as image data, as claimed.

As to independent claims 2 and 9, RECOMMEND-IT does not specifically disclose receiving new (unregistered) ads information from these advertisers and designations of already registered resources.

However, Official Notice is taken that accepting new (unregistered) information from clients and correlating new information with other client's data already belonging to the same clients is well-known in order to correlatively update the clients' existing data with new data.

(Applicants argue against this Official Notice (Response page 12) but does not point out with specificity the supposed errors i.e. did not state why the Official Notice not well-known therefore the challenge is defective. See MPEP 2144.03 C) .

"To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241")

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these customary methods to the system of RECOMMEND-IT above to allow adding new advertising data (such as new details of the sites or new images/icons of ads] to the ad resources (e.g. the game URL's in RECOMMEND-IT), in the correlative database to allow

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updating the data associated with the sites (e.g. icons, further details of the shopping or game sites) for the consumers' benefit.

RECOMMEND-IT also disclose (dependent claim 4) at the citations above.

RECOMMEND-IT does not specifically disclose (dependent claim 3) communicating with clients using their addresses, to ask their permission to correlate the new information with certain existing data already registered as belonging to them, and with their permission, so perform the correlation, as claimed. However Official Notice is taken that asking permission in such situations is customary to ensure correct correlation of data, secure client authorization and thus their satisfaction.

(Arguments against this Official Notice (Response page 12) is defective as lacking specificity as well, see above)

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to add such customary methods to RECOMMEND-IT for the above-discussed advantage.

9. Claims 5-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over RECOMMEND-IT/ Porat, and further in view of Goldhaber et al., US 5,794,210.

RECOMMEND-IT/ Porat discloses (independent claim 11) linking from the recommended site represented by an image to the site and Porat further discloses interacting at the site to request detailed information associated with the ad sent, and the system returning the detailed information (Fig. 6; [0045]; [0046]).

Recommend-it does not disclose (independent claim 11) the steps of monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access.

However these steps are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3) .

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of Recommend-it to effect the ad compensation/charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

RECOMMEND-IT/ Porat/Goldhaber discloses (dependent claims 5-8) at the citations above.

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Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 20, 2007

KHL


DONALD L. CHAMPAGNE
PRIMARY EXAMINER